

REMARKS

Claims 17-20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 17 and 18 are objected to under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claims 8-12 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of four references, namely Great Britain '870 in view of Japan '104, Europe '137 and Sandstrom, et al. (U.S. 5,216,066). Additionally, Claims 5 and 17-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of five references, namely Great Britain '870, Japan '104, Europe '137 and Sandstrom, et al., further in view of Kirk-Othmer.

The Rejections Under 35 U.S.C. 112

Applicant respectfully requests that the rejection under 35 U.S.C. 112 be withdrawn in view of the amendments presented herein. In particular, Claim 17 has been amended to clarify whether it is a tire claim or a method claim. Claims 5, 17 and 18 are amended to render them consistent in scope with Claims 17 and 18 and to clarify they are intended to further limit their respective base claims.

The Rejections Under 35 U.S.C. 103(a)

Applicant respectfully requests reconsideration of the rejections under 35 U.S.C. 103(a). Applicant respectfully submits that the combination of references on which the rejections are based does not teach or suggest the combination of components comprising Applicant's non-marking tread cap as recited in Claims 5 and 8 (the only independent claims presently pending), and further does not teach or suggest the ranges of the components comprising the tread cap as recited in Claim 8.

The cited references even when combined (assuming they can be properly combined) fail to teach all of the components of the presently pending independent claims. None of the references either alone or together teach or suggest a combination of natural and synthetic rubber and ethylene propylene rubber (EPR), as recited in Claim 8, or additionally, polybutadiene rubber as recited in Claims 5 and 15.

For example, none of the cited references teaches or suggests ethylene propylene rubber (EPR). The Office Action relies on Sandstrom as teaching EPDM (ethylene-

propylene terpolymer). EPDM, however, is not ethylene-propylene rubber (EPR) recited in the claims. According to The Condensed Chemical Dictionary, ethylene-propylene rubber (EPR) is an elastomer made by the stereospecific copolymerization of ethylene and propylene. EPR cannot be vulcanized with sulfur, but can be cured with peroxides. In contrast, according to The Condensed Chemical Dictionary, EPDM is an elastomer based on stereospecific linear terpolymers of ethylene, propylene and small amounts of a nonconjugated diene. EPDM can be vulcanized with sulfur. Thus, EPR is a co-polymer and EPDM is a terpolymer. A copy of these definitions from The Condensed Chemical Dictionary is enclosed. Sandstrom recognizes this difference between EPR and EPDM. In reference to the typical activators for the sulfonamide modified EPDM terpolymers disclosed in Sandstrom, Sandstrom comments that peroxides are not part of the activators, vulcanizing or cross-linking agents of sulfonamide modified EPDM since the same are generally detrimental to the diene rubbers. See Column 6, lines 65-69.

None of the other cited references teach or suggest ethylene propylene rubber (EPR) or the combination of natural and synthetic rubber, ethylene propylene rubber and polybutadiene rubber as recited in Claim 5.

To properly support an obviousness rejection under 35 U.S.C. §103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W.L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

“The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ...” Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention.”

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

Applicant respectfully submits the rejections impermissibly pick and choose from the references using Applicant's disclosure as the road map. The rejections are based on a combination of four references in regards to Claim 8 and five references in regards to Claim 5, and the references when considered as a whole teach inconsistent tread compositions, and inconsistent ranges or amounts of components comprising the tread composition. There is no citation in the Office Action to any teaching in any of the references to select one component or ingredient over another, and particularly to select one range or amount of an ingredient over another.

GB '870, for example, does not teach or suggest all of the components of Applicant's non-marking tread cap. As non-limiting examples, this reference does not teach the inclusion of ethylene propylene rubber (EPR) or white carbon, and it only teaches 0-1 pts. carbon black. Japan '104 does not teach the use of ethylene propylene rubber (EPR) or rubber oil. Nor does it teach the inclusion of polybutadiene rubber in addition to natural and synthetic rubber. Moreover, it only teaches 10 pts. natural and synthetic rubber and 0-1 pts. carbon black. Europe '137, on the other hand, discloses a sulfur-vulcanizable rubber mixture containing no aromatic process oil. See Abstract, line 1. Additionally, from the Abstract provided, Europe '137 does not teach the use of natural and synthetic rubber in addition to polybutadiene rubber or the use of ethylene propylene rubber (EPR).

The references when taken in combination show that Applicant's claimed tread cap composition is not obvious. The Office Action ignores the inconsistencies in the teachings of the references and thus ignores their teachings as a whole. "(P)rior art references before the tribunal must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention." Akzo N.V. v. U.S. Intern. Trade Com'n, 808 F.2d 1471, 1481, 1 U.S.P.Q. 2d 1291 (Fed Cir. 1986), cert. denied, 482 U.S. 909.

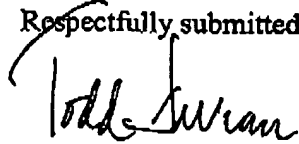
The Kirk-Othmer reference teaches all types of agents. There is no citation in the Office Action to any teaching on how to select some, but not all, of such agents and further how to determine how much of a selected agent to use. Applicant submits that the teaching or suggestion to make the combination of components in the amount of components recited in Applicant's claims is found only in Applicant's own specification.

The comments in the Office Action that a particular claimed amount of a compound would have been obvious and could have been determined without undue experimentation is the same as arguing something is a design choice. The bare assertion that something is a design choice, however, is insufficient to establish a "suggestion" in the art for the claimed invention. See e.g., Northern Telecom, Inc. v. Data Point Corp., 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990). Also, as set forth by the Board of Patent Appeals and Interferences, the statement that something is a design choice is a conclusion and not a reason. Ex parte Garrett, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. Intrf. 1986). Since the Office Action has not provided the particular claimed components and their amounts, the Office Action has not established a *prima facie* case of obviousness of claims and their rejection should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that the remaining claims of this application are now in condition for allowance and such action is respectfully solicited.

Respectfully submitted,



Todd Deveau

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**

100 Galleria Parkway, NW, Suite 1750
Atlanta, Georgia 30339
Phone: 770.933.9500
E-mail: todd.deveau@tkhr.com